

**REMARKS**

**1. Summary of Rejections in the Office Action of September 10, 2003**

At page 3, paragraph 5 of the Office Action, the Examiner rejects claims 1, 2, 4-6, and 13-19 under 35 U.S.C. § 103(a), as allegedly being obvious in view of U.S. Patent No. 6,061,733 to Bodin *et al.* ("Bodin") and U.S. Patent No. 6,237,039 B1 to Perlman. At page 9, spanning paragraphs 18-20 of the Office Action, the Examiner also rejects claims 3 and 7-12 under 35 U.S.C. § 103(a), as allegedly being obvious in view of Bodin, Perlman, and U.S. Patent No. 6,477,522 B1 to Young.

**2. 35 U.S.C. § 103(a) Rejections**

At page 3, paragraph 5 of the Office Action, the Examiner rejects claims 1, 2, 4-6, and 13-19 under 35 U.S.C. § 103(a), as allegedly being obvious in view of Bodin and Perlman, and at page 9, spanning paragraphs 18-20 of the Office Action, the Examiner rejects claims 3 and 7-12 under 35 U.S.C. § 103(a), as allegedly being obvious in view of Bodin, Perlman, and Young.

The Applicants respectfully TRAVERSE the Examiner's rejections and assert the following remarks in response:

In order for the Examiner to establish a prima facie case for obviousness, three (3) criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as the Examiner proposes. Second, there must be a reasonable

expectation of success in connection with the Examiner's proposed combination of the references. And third, the prior art references must disclose or suggest all of the claim limitations. MPEP 2143. Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." MPEP 2143.01 (emphasis added.) Further, "[i]t is improper to combine references where the references teach away from their combination." MPEP 2145 (emphasis added.) The Applicants maintain that the Examiner fails to establish a prima facie case for obviousness because the Examiner's modifications to Bodin change the principle of operation of Bodin, and Bodin teaches away from its modification to include those claimed limitations of claims 1-19, which are missing from Bodin.

**a. Independent Claims 1 and 7**

The Applicants' independent claims 1 and 7 each describes a system comprising "a software delegate . . . configured to control an amount of said data and a size of said at least one portion of said network object to be downloaded from said server facility to said client independent of a user of said client and based solely upon an operating state of said client." (Emphasis added.) At page 3, paragraph 6, of the Office Action, the Examiner acknowledges that Bodin does not disclose or suggest that the at least one portion of the network object may be downloaded independent of a user of the client and based solely upon the operating state of the client. However, at page

4, paragraph 6 of the Office Action, the Examiner alleges that Perlman discloses or suggests these elements missing from Bodin, and that it would have been obvious to those of ordinary skill in the art at the time of the invention to modify Bodin to include these missing elements. For the reasons set forth below, the Applicants maintain that modifying the Bodin, such that the at least one portion of the network object is downloaded independent of a user of the client and based solely upon the operating state of the client, improperly changes the “principle of operation” of Bodin. The Applicants also maintain that Bodin teaches away from this modification.

For example, Bodin states that its invention “relates to a method and apparatus for passing a large file from a server machine to a client machine as a collection of smaller files. This is achieved without breaking up the large file on the server machine.” Bodin, Column 2, Lines 14-17 (emphasis added.) Specifically, “it is never possible to split a file into optimized segments for every potential user’s computer wishing to download the file, since the ideal size of a split file is known only by the user downloading the split file.” *Id.* at Column 1, Lines 61-65 (emphasis added.) Therefore, in Bodin, “[s]erver code is provided implementing a user interface. The user interface allows a user on the client machine to input the name of the file to be downloaded. A pull-down menu allows the user to specify portion sizes for the file to be downloaded based on the capabilities and transfer rates of the client’s machine.” *Id.* at Lines 19-24 (emphasis added.) Thus, the “principle of operation” of the system in Bodin is that the download of the files occur based on the “capabilities and the

transfer rates” of the client’s machine. The system of Bodin facilitates this principle of operation by allowing the user of the client’s machine to specify the size of the file which the client machine will download because only the user of the client machine knows the ideal size of the file.

In contrast, Perlman describes a system in which a server transfers auxiliary data, such as advertisements, to a client machine without the user knowing that the server is transferring the auxiliary data to the client machine. See, e.g., Perlman, Column 5, Lines 27-29; and Column 6, Lines 60-64. Specifically, the server first transfers the auxiliary data to the client machine when the client machine is in an “idle state,” and subsequently the client machine displays the previously transferred auxiliary data to the user when the client machine is in a “fetching state.” See, e.g., *Id.* at Column 7, Lines 61-67; and Column 8, Lines 1-23. Thus, the transfer of the auxiliary data to the client machine and the display of the auxiliary data to the user is based on the operating state of the client machine and is independent of the capabilities and the transfer rates of the client machine.

As set forth above, the “principle of operation” of the system in Bodin is that the download of the files occur based on the “capabilities and the transfer rates” of the client’s machine. The Applicants maintain that modifying the system of Bodin in view of the system of Perlman improperly modifies the “principle of operation” of Bodin because such a modification results in the system of Bodin downloading files from the server machine to the client machine irrespective of the capabilities and the transfer rates of the client machine.

The Applicants also maintain that Bodin teaches away from this modification. For example, as set forth above, Bodin states that its invention “relates to a method and apparatus for passing a large file from a server machine to a client machine as a collection of smaller files. This is achieved without breaking up the large file on the server machine.” Bodin, Column 2, Lines 14-17. Specifically, “it is **never possible to split a file into optimized segments for every potential user’s computer wishing to download the file**, since the ideal size of a split file is **known only by the user downloading the split file.**” *Id.* at Column 1, Lines 61-65 (emphasis added.) Because Bodin states that the ideal size of the file only is known by the user, and consequently, it never is possible to split the file into optimized segments for every potential user’s computer, Bodin clearly teaches away from **any modification which removes the user’s ability to select the size of the file which the server machine will download to the client machine.** (Emphasis added.) Therefore, the Applicants respectfully request that the Examiner withdraw the obviousness rejection of claims 1 and 7, and allow the same to issue in a U.S. patent.

**b. Independent Claim 13**

The Applicants’ independent claim 13 describes a method comprising the step of “controlling a size of said portions of said network object received from said server facility **independent of a user of said client computer and based solely upon an operating state of said client computer.**” (Emphasis added.) At page 6, paragraph 11, of the Office Action, the Examiner

acknowledges that Bodin does not disclose or suggest the step of controlling the size of the portions of the network object independent of the user of the client computer and based solely upon the operating state of the client computer. However, at page 6, paragraph 11 of the Office Action, the Examiner alleges that Perlman discloses or suggests this step, and that it would have been obvious to those of ordinary skill in the art at the time of the invention to modify Bodin to include this step. For the reasons set forth below, the Applicants maintain that modifying Bodin, such that the size of the portions of the network object is controlled independent of a user of the client and based solely upon the operating state of the client, improperly changes the “principle of operation” of Bodin. The Applicants also maintain that Bodin teaches away from this modification.

For example, as set forth above, Bodin states that “it is never possible to split a file into optimized segments for every potential user’s computer wishing to download the file, since the ideal size of a split file is known only by the user downloading the split file.” *Id.* at Column 1, Lines 61-65 (emphasis added.) Therefore, in Bodin, “[s]erver code is provided implementing a user interface. The user interface allows a user on the client machine to input the name of the file to be downloaded. A pull-down menu allows the user to specify portion sizes for the file to be downloaded based on the capabilities and transfer rates of the client’s machine.” *Id.* at Lines 19-24 (emphasis added.) Thus, the “principle of operation” of the method in Bodin is that the download of the files occur based on the “capabilities and the

transfer rates” of the client’s machine. The method of Bodin facilitates this principle of operation by allowing the user of the client’s machine to specify the size of the file which the client machine will download because only the user of the client machine knows the ideal size of the file.

In contrast, Perlman describes a method in which a server transfers auxiliary data, such as advertisements, to a client machine without the user knowing that the server is transferring the auxiliary data to the client machine. See, e.g., Perlman, Column 5, Lines 27-29; and Column 6, Lines 60-64. Specifically, the server first transfers the auxiliary data to the client machine when the client machine is in an “idle state,” and subsequently the client machine displays the previously transferred auxiliary data to the user when the client machine is in a “fetching state.” See, e.g., *Id.* at Column 7, Lines 61-67; and Column 8, Lines 1-23. Thus, the transfer of the auxiliary data to the client machine and the display of the auxiliary data to the user is based on the operating state of the client machine and is independent of the capabilities and the transfer rates of the client machine.

As set forth above, the “principle of operation” of the method in Bodin is that the download of the files occur based on the “capabilities and the transfer rates” of the client’s machine. The Applicants maintain that modifying the method of Bodin in view of Perlman improperly modifies the “principle of operation” of Bodin because such a modification results in Bodin downloading files from the server machine to the client machine irrespective of the capabilities and the transfer rates of the client machine.

The Applicants also maintain that Bodin teaches away this modification. For example, as set forth above, Bodin states that “it is **never possible to split a file into optimized segments for every potential user’s computer wishing to download the file**, since the ideal size of a split file is **known only by the user downloading the split file.**” *Id.* at Column 1, Lines 61-65 (emphasis added.) Because Bodin states that the ideal size of the file only is known by the user, and consequently, it never is possible to split the file into optimized segments for every potential user’s computer, Bodin clearly teaches away from **any modification which removes the user’s ability to select the size of the file which the server machine will download to the client machine.** (Emphasis added.) Therefore, the Applicants respectfully request that the Examiner withdraw the obviousness rejection of claims 13, and allow the same to issue in a U.S. patent.

c. **Dependent Claims 2-6, 8-12, and 14-19**

Claims 2-6, 8-12, and 14-19 depend from independent claims 1, 7, and 13, respectively. “If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious.” MPEP 2143.03 (citations omitted). Therefore, the Applicants respectfully request that the Examiner also withdraw the obviousness rejections of claims 2-6, 8-12, and 14-19, and allow the same to issue in a U.S. patent.



**CONCLUSION**

The Applicants respectfully submit that the above-titled patent application is in condition for allowance, and such action is earnestly requested. If the Examiner believes that an in-person or telephonic interview with the Applicants' representatives will in any way expedite the examination of the above-titled patent application, the Examiner is invited to contact the undersigned attorney of record. The Applicants are including a check in the amount of \$770 covering the requisite large entity fee for filing a Request for Continued Examination. Moreover, on March 10, 2004, the Applicants previously filed a Notice of Appeal, and paid the requisite large entity fee of \$950 for a three month extension of time and the requisite large entity fee of \$330 for filing a Notice of Appeal. However, in the event of any variance between the fees determined the Applicants and those determined by the U.S. Patent and Trademark Office, please charge any such variance to the undersigned's Deposit Account No. 01-2300.

Respectfully submitted,

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